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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,520	08/29/2001	Wayne Odom	KARAWAY01-01	9628

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EXAMINER	
HOEL, MATTHEW D	
ART UNIT	**PAPER NUMBER**
3713	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/942,520	ODOM, WAYNE	
	Examiner	Art Unit	
	Matthew D. Hoel	3713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7,8 and 12-28* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7,8 and 12-28* is/are rejected.

7)☒ Claim(s) *14,20* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *08/29/2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
2. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
3. Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
4. Claim 15 to 18 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 11 and 14 of copending Application No. 09/977,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because: '138 claims a method for playing a wagering game using an inventory of indicia (Claim 11). '138 claims the inventory of indicia, when fully constituted, having X number of indicia arranged in sets of at least two indicia each (it is inherent that the deck of cards mentioned in Claim 11 of '138 will have 52 cards consisting of four suits of 13 cards each). The player of '138 makes a wager (Claim 11) to play each of a series of hands (Claim 14, dependent from

Claim 11). '138 claims, for each hand of play, randomly selecting and displaying a plurality of individual indicia from the inventory, the combination of indicia selected and displayed defining at least one hand outcome and depleting the selected indicia from play for subsequent hands (Claim 11). '138 claims prior to the play of the next hand displaying the number of each indicia remaining in each indicia set in the inventory as depleted (Claim 11). '138 claims displaying any scheduled winning outcomes eliminated as a result of depletion of the indicia inventory (Claim 11). '138 Claims comparing the hand outcome to a predetermined schedule of winning outcomes, and if said outcome matches one of the schedule of winning outcomes, issuing an award to a player (Claim 11).

5. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Claims 19 to 22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 11 and 14 of copending Application No. 09/977,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because: '138 claims an electronic device for a player to play a game utilizing an inventory of X game indicia arranged in sets of at least two indicia each (Claim 11, it is inherent that the deck of cards mentioned in Claim 11 of '138 will have 52 cards consisting of four suits of 13 cards each). '138 claims a processor storing data corresponding to the inventory (Claim 11). '138 claims a video display and a means for a player to make a wager and prompt play of the game (Claim 11). '138 claims randomly selecting and displaying a combination of

individual indicia selected from the inventory of indicia, the selected and displayed combination defining at least one outcome (Claim 11). The selected indicia of '138 are removed from selection for future hands (Claim 11). '138 compares each outcome to a predetermined schedule of winning outcomes stored in a data structure and issues an award for each selected and displayed winning outcome (Claim 11). '138 displays prior to the play of the next hand data corresponding to the remaining inventory of indicia sets depleted of displayed game indicia (Claim 11). '138 displays scheduled winning outcomes unavailable due to depletion (Claim 11). The processor of '138 is configured to, for the next hand of play, select indicia from the depleted inventory (Claim 14, dependent on Claim 11).

7. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claim 23, 7, and 8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 11 of copending Application No. 09/977,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because: '138 claims a method for playing a wagering game using an inventory of indicia, the inventory when fully constituted having X number of individual indicia, and a player making a wager to play each of a series of hands (Claim 11). '138, for each hand of play, randomly selects and displays a plurality of individual indicia from the inventory, the combination of individual indicia selected and displayed defining a winning or losing outcome for the hand and depleting the displayed individual indicia for play of the next hand (Claim 11). '138 issues an award for a

winning outcome (Claim 11). '138, prior to the commencement of the next hand of play, displays to the player information regarding any winning outcomes eliminated by the depletion of indicia (Claim 11). The player makes another wager prior to playing a hand using the depleted inventory (Claims 11 and 14).

9. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claim 24 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 11 and 14 of copending Application No. 09/977,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because: '138 claims a method for playing a wagering game using an inventory of indicia, the inventory when fully constituted having X number of individual indicia arranged in indicia sets of at least two indicia each, a player making a wager to play a game, serially selecting and displaying a plurality of individual indicia from the inventory, the combination of indicia defining a winning or losing outcome, depleting the indicia from the inventory available for play of subsequent hands, issuing an award to a player for a winning outcome, and displaying winning outcomes depleted by elimination of indicia and the number of the indicia in each set remaining in inventory (Claim 11). '138 claims arranging the inventory into a random serial order and commanding reconstitution of the inventory to X prior to the play of the next game (Claim 14). '138 claims the player making another wager to play the game using the depleted inventory (Claims 11 and 14).

11. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claim 25 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 17 and 20 of copending Application No. 09/977,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because: '138 claims a method for playing a wagering game using an inventory of indicia sets (poker deck of N cards, Claim 17). '138 claims a player making a wager to play the game (Claim 17). For each hand of game play, a plurality of indicia from the inventory are randomly selected and displayed into the coordinates of a game matrix (electronic display of hand of poker cards, Claim 17). The plurality of combinations of indicia define a plurality of winning or losing outcomes, and the indicia are depleted form the inventory for play in subsequent hands (Claim 17). '138 issues an award to a player for a winning outcome. '138 displays the number of indicia remaining in the sets in the inventory and displays any winning outcomes eliminated as a result of depletion (Claim 17). The player can make another wager to play a next game using the depleted inventory (Claim 17) or command reconstitution of the inventory to X prior to the play of the next game (Claim 20, dependent from 17).

13. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

14. Claims 26 to 28, 12, and 14 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claims 11

and 14 of copending Application No. 09/977,138. Although the conflicting claims are not identical, they are not patentably distinct from each other because: '138 claims an electronic device for a player to play a game utilizing an inventory of X game indicia, comprising a computer processor storing an arrangement of the inventory, a video display, a means for the player to make a wager and prompt play of the game (Claim 11). '138 claims, in response to the prompting, randomly selecting and displaying indicia selected from the plurality of indicia defining an outcome, and precluding the selected indicia from further selection from the inventory (Claim 11). '138 claims comparing the outcome to a schedule of winning outcomes stored in the data structure, issuing an award for a winning combination, and displaying prior to play of the next hand any scheduled winning outcomes eliminated by the depletion of indicia (Claim 11). '108 Claims prompting the processor to reconstitute the inventory of indicia to X (Claim 14).

15. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

16. Claim 15 is provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over Claim 1 of copending Application No. 11/007,108. Although the conflicting claims are not identical, they are not patentably distinct from each other because: '108 claims a method for playing a wagering game using an inventory of indicia (Claim 1). The inventory of '108, when fully constituted, has X number of indicia arranged in sets of at least two indicia each (multiple hands in

inventory, each hand having plural indicia, "indicia" being plural of "indicium," Claim 1). '108 claims a player making a wager to play each of a series of hands (steps (a)-(e) repeated, Claim 1). '108 claims, for each hand of play, randomly selecting and displaying a plurality of indicia from the inventory, the combination of indicia selected and displayed defining at least one game outcome and depleting the selected indicia from play for subsequent hands (Claim 1). '108 compares the hand outcome to a predetermined schedule of winning outcomes and if the hand outcome matches one of the schedule of winning outcomes, issues an award to a player (Claim 1). '108 claims prior to play of the next hand, displaying the number of indicia remaining in each indicia set in the inventory as depleted (Claim 1). '108 also claims displaying any scheduled winning outcomes eliminated as a result of depletion of the indicia inventory (Claim 1).

17. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Specification

18. The disclosure is objected to because of the following informalities: Page 6, Line 21 cites "serail order." The examiner believes the applicant intends to cite "*serial* order." The same line also cites "1-X." It would be more clear if the line cited "1 to X" or "1 through X," as the applicant is intending to state that 63 cards (X=63, Page 6, Line 22) are in random order, cards 1 to 63. The line as it is written looks like "1-63," which is negative sixty-two. This is confusing at first glance to the reader. Page 7, Line 5 also cites "1-X order."

19. Appropriate correction is required.

Drawings

20. The drawings are objected to because Figs. 1 and 2 are dithered screenshots of a video game display. They did not preclude examination, but they are informal, and some of the details are hard to make out. Formal line drawings would be appropriate for publication should the application issue. Also, the serial number and date of the application were printed on Figs. 1 and 2 as they were scanned into the IFW/PAIR system, obscuring some of the reference numbers. Also, Fig. 4 is an informal hand drawing. Reel 104a was not indicated on Fig. 4. The payout table 128 in Fig. 4 also is not clear. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

21. Claim 14 is objected to because of the following informalities: "serail" is cited in the fourth line. The examiner believes the applicant intends to cite "serial." Appropriate correction is required.

22. Claim 20 is objected to because of the following informalities: "indica" is cited in the third line. The examiner believes the applicant intends to cite "indicia." Appropriate correction is required.

Claim Rejections - 35 USC § 112

23. The following is a quotation of the second paragraph of 35 U.S.C. 112:

24. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

25. Claims 8, 14, 18, 22, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 8 cites "serial order 1-X." Claim 14 cites "serial order 1-X" twice. Claim 18 cites "serial order of 1-X." Claim 22 cites "serial order 1-X." Claim 24 cites "serial order 1-X." This is confusing to the reader as it appears to be "one *minus* X" instead of "one *to* X" or "one *through* X." Based on the specification and the other claims, the examiner believes that the applicant intends

to say that there are X number of indicia, arranged randomly in a series 1 to X. Citing "1 to X" or "1 through X" would clarify this discrepancy.

26. Claims 16, 17, 19, 20, 24, 25, 26, 27, and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 16 cites "inventory to X"; Claim 17 cites "inventory to X"; Claim 19 cites "X game indicia"; Claim 20 cites "inventory to X"; Claim 24 cites "inventory to X"; Claim 25 cites "inventory to X"; Claim 26 cites "X game indicia"; Claim 27 cites "inventory to X"; and Claim 28 cites "inventory to X." Changing these limitations to "inventory to X number of indicia" or "X number of game indicia" would make it clear that the inventory of indicia, when fully constituted, contains X number of indicia. Otherwise, one of skill in the art without seeing the specification could interpret X to be an array containing each individual indicium, instead of X being the number of indicia in the inventory.

27. Claim 20 recites the limitation "reconstitute" in the second line. There is insufficient antecedent basis for this limitation in the claim. It is understood from the other independent claims that "to reconstitute said indicia inventory to X" means to add indicia to the inventory so that it has X number of indicia. This definition of "constituted," however, does not appear in independent Claim 19, as it does in independent claims 15, 23, 34, and 25.

28. Claim 27 recites the limitation "reconstitute" in the second line. There is insufficient antecedent basis for this limitation in the claim. It is understood from the other independent claims that "to reconstitute said indicia inventory to X" means to add

indicia to the inventory so that it has X number of indicia. This definition of "constituted," however, does not appear in independent Claim 26, as it does in independent claims 15, 23, 34, and 25.

Claim Rejections - 35 USC § 101

29. 35 U.S.C. 101 reads as follows:

30. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

31. Claims 15 to 18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 15 cites a method for playing a wagering game using an inventory of indicia. The claim as it is written appears to be merely a set of rules for playing a game, and as such, being a manipulation of abstract ideas. It does not pertain to an array of indicia, such as a virtual deck of cards, being stored in the physical memory of a gaming device, or being displayed on a physical display device such as a CRT or LCD when they are dealt to the player. It also does not pertain to a game played with a physical deck of cards on a physical playing table, such as that found in a casino. Method claims must have a concrete, tangible, and useful result.

32. Claims 23 to 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 23, 24, and 24 cite methods for playing a wagering game using an inventory of indicia. The claims as they are written appear to be merely sets of rules for playing a game, and as such, being manipulations of abstract ideas. They do not pertain to an array of indicia, such as a virtual deck of

cards, being stored in the physical memory of a gaming device, or being displayed on a physical display device such as a CRT or LCD when they are dealt to the player. They also do not pertain to a game played with a physical deck of cards on a physical playing table, such as that found in a casino. Method claims must have a concrete, tangible, and useful result.

Conclusion

33. The examiner has conducted an extensive search and has found no references that properly read on the claims, in particular displaying the remaining indicia left in the inventory and displaying the winning outcomes eliminated as a result of inventory depletion. The previous rejections are withdrawn. Filing terminal disclaimers to overcome the double patenting rejections and rewriting them to overcome the 101 and 112 rejections will place the application in condition for allowance.

34. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew D. Hoel whose telephone number is (571) 272-5961. The examiner can normally be reached on Mon. to Fri., 8:00 A.M. to 4:30 P.M.

35. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Matthew D. Hoel, Patent Examiner
AU 3713

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TC3700